

Attorney Docket No. 9400-212

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Paul T. Watson, *et al.*

Serial No.: 10/028,153

Filed: December 20, 2001

For: SYSTEM AND METHOD FOR CONTENT TRANSMISSION NETWORK  
SELECTION

Group Art Unit: 2157

Examiner: Emmanuel Coffy

Confirmation No.: 3651

June 2, 2006

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**APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. §41.37**

Sir:

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed April 7, 2006.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. Sec. 1.136(a). Any additional fees believed to be due may be charged to Deposit Account No. 50-0220.

**Real Party In Interest**

The real party in interest is assignee BellSouth Intellectual Property Corporation, a corporation of Delaware having a place of business at 824 Market Street, Suite 510, Wilmington, Delaware 19801.

**Related Appeals and Interferences**

The Appellant is aware of no appeals or interferences that would be affected by the present appeal.

**Status of Claims**

In the Final Office Action of January 11, 2006, all pending claims (*i.e.*, Claims 1-30) from the Amendment of October 25, 2005, were rejected. The Appellant appeals the final

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rejection of the subject matter of Claims 1-30 (as presented in the Amendment of October 25, 2005).

### **Status of Amendments**

The Appellant filed an Amendment on October 25, 2005, amending Claims 1-3, 13-17, and 19-24, and adding new Claims 25-30. The Amendment of October 25, 2005, was filed responsive to the non-final Office Action of July 27, 2005, and the Amendment of October 25, 2005, was entered.

The Patent Office issued a Final Office Action on January 11, 2006, and responsive to the Final Office Action, the Appellant filed a Request For Reconsideration on March 2, 2006. No amendments were presented with the Request For Reconsideration of March 2, 2006. Accordingly, the claims presented with the Amendment of October 25, 2005, are currently pending for consideration in this Appeal.

The attached Appendix A presents the pending Claims 1-30 as amended in the Appellant's Amendment filed October 25, 2005, which has been formally entered at this time.

### **Summary of Claimed Subject Matter**

The Appellant appeals the final rejection of independent Claims 1, 16, and 19 as being patentable over the combination of U.S. Patent No. 6,766,526 to Ellis (the '526 patent) and International Publication No. WO 99/60790 also to Ellis (the '790 publication). The Appellant further appeals the final rejection of dependent Claims 25, 27, and 29 as being patentable over the combination of the '526 patent, the '790 publication, and U.S. Patent No. 6,483,110 to Rai et al. (Rai). The remaining dependent claims are patentable at least as depending from a patentable independent claim.

Independent Claim 1 (as presented in the Amendment of October 25, 2005) is directed to a method for content transmission network selection in a system coupled in parallel through both of a broadcast network and a broadband network to a viewer location wherein the broadcast network and the broadband network are different. Independent Claims 16 and 19 (as presented in the amendment of October 25, 2006) are respectively directed to a computer readable medium and to a system analogous to the method of Claim 1.

With respect to Claim 1, a method is recited for content transmission network selection in a system 120 coupled in parallel through both of a broadcast network 123 and a broadband network 121 to a viewer location 100 wherein the broadcast network 123 and the

broadband network 121 are different. The method includes identifying video programming content to be transmitted to the viewer location 100 based on a transmission request. As shown for example in Figure 1, a content decision server 120b may receive a viewer's request for a content item. *See* Application, page 4, lines 25-26. One of the broadcast network 123 or the broadband network 121 is selected for transmission of the video programming content to the viewer location 100 based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed. The content decision server 120b may select a network over which to transmit the content. *See*, Application, page 4, lines 25-27. *See also*, Application, Figure 2, block 218, and page 5, lines 16-17. Moreover, the selection is based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time. *See*, Application, page 5, lines 21-23, page 7, lines 15-17, and page 8, lines 14-16. The video programming content is transmitted on the selected one of the broadcast network 123 or the broadband network 121 to the viewer location 100 coupled to both of the broadcast network 123 and the broadband network 121. As further shown in Figure 1, content media server 120c may queue and transmit the content to the selected transmission network. *See*, Application, page 4, lines 27-29. *See also*, Application, Figure 2, block 224, and page 7, lines 3-4.

Dependent Claim 25 depends from Claim 1 and thus includes all recitations of Claim 1 as discussed above. In addition, Claim 25 recites that the video programming content comprises first video programming content, wherein the transmission request comprises a first transmission request, and wherein selecting one of the broadcast network 123 or the broadband network 121 comprises selecting the broadcast network 123. In addition, second video programming content to be transmitted based on a second transmission request is identified, and the first and second transmission requests are different. The broadband network 121 is selected for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed. The selection of the broadband network 121 is based at least in part on an option of delivering the second video programming content either at a time that the second request is received or at the future time. The second video programming content is transmitted on the broadband network 121.

With respect to Claim 16, a computer readable medium is recited for a transmission network selector 120 coupled in parallel through both of a broadcast network 123 and a

broadband network 121 to a viewer location 100, and the broadcast network 123 and the broadband network 121 are different. The computer readable medium has stored thereon computer readable instructions to identify video programming content to be transmitted to the viewer location 100 based on a transmission request. As shown for example in Figure 1, a content decision server 120b may receive a viewer's request for a content item. *See* Application, page 4, lines 25-26. In addition, the computer readable medium has stored thereon computer readable instructions to select one of the broadcast network 123 or the broadband network 121 for transmission of the video programming content to the viewer location 100 based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed. The content decision server 120b may select a network over which to transmit the content. *See*, Application, page 4, lines 25-27. *See also*, Application, Figure 2, block 218, and page 5, lines 16-17. The selection is based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time. *See*, Application, page 5, lines 21-23, page 7, lines 15-17, and page 8, lines 14-16. The computer readable medium also has stored thereon computer readable instructions to transmit the video programming content on the selected one of the broadcast network 123 or the broadband network 121 to the viewer location 100. As further shown in Figure 1, content media server 120c may queue and transmit the content to the selected transmission network. *See*, Application, page 4, lines 27-29. *See also*, Application, Figure 2, block 224, and page 7, lines 3-4.

Dependent Claim 27 depends from Claim 16 and thus includes all recitations of Claim 1 as discussed above. In addition, Claim 27 recites that the video programming content comprises first video programming content, that the transmission request comprises a first transmission request, and that selecting one of the broadcast network 123 or the broadband network 121 comprises selecting the broadcast network 123. The computer readable medium also has stored thereon computer readable instructions to identify second video programming content to be transmitted based on a second transmission request wherein the first and second transmission requests are different. In addition, the computer readable medium has stored thereon computer readable instructions to select the broadband network 121 for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed. The selection of the broadband network 121 being based at least in part on an option of delivering the second video programming content

either at a time that the second request is received or at the future time. Moreover, the computer readable medium has stored thereon computer readable instructions to transmit the second video programming content on the broadband network 121.

With respect to Claim 19, a system is recited for content transmission network selection wherein the system is coupled in parallel through both of a broadcast network 123 and a broadband network 121 to a viewer location 100. Moreover, the broadcast network 123 and the broadband network 121 are different. The system includes a processor 420 operative to execute computer executable instructions and memory 424. The memory 424 has stored therein computer executable instructions to identify video programming content to be transmitted to the viewer location 100 based on a transmission request. As shown for example in Figure 1, a content decision server 120b may receive a viewer's request for a content item. *See* Application, page 4, lines 25-26. The memory 424 also has stored therein computer executable instructions to select one of the broadcast network 123 or the broadband network 121 for transmission of the video programming content to the viewer location 100 based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed. The content decision server 120b may select a network over which to transmit the content. *See*, Application, page 4, lines 25-27. *See also*, Application, Figure 2, block 218, and page 5, lines 16-17. The selection is based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time. *See*, Application, page 5, lines 21-23, page 7, lines 15-17, and page 8, lines 14-16. In addition, the memory 424 has stored therein computer executable instructions to transmit the video programming content on one of the selected of the broadcast network 123 or broadband network 121 to the viewer location 100. As further shown in Figure 1, content media server 120c may queue and transmit the content to the selected transmission network. *See*, Application, page 4, lines 27-29. *See also*, Application, Figure 2, block 224, and page 7, lines 3-4.

Dependent Claim 29 depends from Claim 19 and thus includes all recitations of Claim 19 as discussed above. In addition, Claim 29 recites that the video programming content comprises first video programming content, that the transmission request comprises a first transmission request, and that selecting one of the broadcast network 123 or the broadband network 121 comprises selecting the broadcast network 123. In addition, the memory 424 has stored therein computer executable instructions to identify second video programming content to be transmitted based on a second transmission request wherein the first and second

transmission requests are different. In addition, the memory 424 has stored therein computer executable instructions to select the broadband network 121 for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed. The selection of the broadband network 121 is based at least in part on an option of delivering the second video programming content either at a time that the second request is received or at the future time. Furthermore, the memory 424 has stored therein computer executable instructions to transmit the second video programming content on the broadband network 121.

### **Grounds of Rejection To Be Reviewed on Appeal**

The subject matter of Independent Claims 1, 16, and 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,766,526 to Ellis (the "526 patent") in view of International Pub. No. WO 99/60790 to Ellis (the "'790 publication"). The subject matter of dependent Claims 25, 27, and 29 stands rejected as being unpatentable over the '526 patent in view of the '790 publication and further in view of U.S. Patent No. 6,438,110 to Rai et al. ("Rai").

In the following remarks, the Appellant will show that independent Claims 1, 16, and 19 are patentable over the '526 patent and the '790 publication, and that dependent Claims 2-15, 17-18, and 20-30 are patentable at least as per the patentability of Claims 1, 16, and 19 from which they depend.

The Appellant will also show that dependent Claims 25, 27, and 29 are separately patentable over the combination of the '526 patent, the '790 publication, and Rai.

### **Arguments**

#### **I. Introduction to 35 U.S.C. § 103 Analysis**

The subject matter of pending Claims 1, 16, and 19 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the '526 patent in view of '790 publication; and the subject matter of pending Claims 25, 27, and 29 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the '526 patent in view of '790 publication and further in view of Rai. A determination under Section 103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), cert. denied, 107 S.Ct. 2187. After

the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office has the initial burden under Section 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art references cited in the rejection, when combined, must teach or suggest all the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings in the manner suggested. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Thus, in support of a Section 103 rejection, particular evidence from the prior art must be provided showing why a skilled artisan, with no knowledge of the claimed invention, would have combined the cited references in the manner claimed in the rejection. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as recently stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

The Appellant respectfully submits that the pending claims are patentable over the cited references because the cited combination fails to disclose or suggest all of the

recitations of the pending claims, and because the reasoning behind such combination has not been established. The patentability of the pending claims is discussed in detail hereinafter.

As analyzed in detail below, the Appellant submits that Claims 1, 16, 19, 25, 27, and 29 are patentable over the cited art.

## **II. Claims 1, 16, 19, 25, 27, And 29 Are Patentable Over The Cited Art**

The subject matter of Claims 1, 16, and 19 stands rejected as being unpatentable over the '526 patent in view of the '790 publication. The subject matter of Claims 25, 27, And 29 stands rejected as being unpatentable over the '526 patent in view of the '790 patent and further in view of Rai. The combinations of the cited art, however, fails to teach or suggest the subject matter of Claims 1, 16, 19, 25, 27, and 29 for at least the reasons discussed below.

### **A. Independent Claims 1, 16, And 19 Are Patentable Over The Cited Art**

Independent Claims 1, 16, and 19 stand rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over U.S. Patent No. 6,766,526 to Ellis (hereinafter "the '526 patent") in view of International PCT Patent Application No. WO 99/60790 to Ellis et al. (hereinafter "the '790 publication"). The Appellant respectfully submits, however, that independent Claims 1, 16, and 19 are patentable for at least the reasons discussed below.

Claim 1, for example, recites a method for content transmission network selection in a system coupled in parallel through both of a broadcast network and a broadband network to a viewer location wherein the broadcast network and the broadband network are different. More particularly, the method includes:

- identifying video programming content to be transmitted to the viewer location based on a transmission request;
- selecting one of the broadcast network or the broadband network for transmission of the video programming content to the viewer location based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed, the selection based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time; and
- transmitting the video programming content on the selected one of the broadcast network or the broadband network to the viewer location coupled to both of the broadcast and broadband networks. (Underline added.)

The Final Office Action of January 11, 2006 (the "Final Office Action"), concedes that the '526 patent "is silent with respect to particular features corresponding to the ordering



of video programming to be subsequently delivered." The Final Office Action, page 3. The Advisory Action of March 16, 2006 (the "Advisory Action"), further states that:

the Examiner relied on the Ellis ('526) patent with respect to the particular existence of a system coupled in parallel through both of a broadcast network and a broadband network to a viewer location wherein the broadcast network and the broadband network are different. As set forth in the rejection and particularly illustrated in Figures 1 and 12, the particularly claimed system architecture is illustrated.

Advisory Action, page 2.

As shown in Figure 12 of the '526 patent, user television equipment 22' may receive television programming from broadcast distribution facility 16a, satellite television distribution facility 16b, and cable system 16c. *See*, the '526 patent, column 10, lines 17-20. In contrast to the method for content transmission network selection of the Appellant's Claim 1, however, the '526 patent discusses a system that allows a user to navigate through all of the available channels from multiple sources. *See*, the '526 patent, col. 10, line 63 to col. 11, line 44. As discussed in the Abstract of the '526 patent:

The displayed information may be program listings information such as the channel designator or the program currently airing on the channel. The displayed information may also be a list of channels. ... The interactive system may allow a user to specify a source identifier to channels from different sources and display the channels with the source identifier when they are entered.

The '526 patent, Abstract. Accordingly, the '526 patent relates to channel reception at a user's television equipment as opposed to network selection for transmission, and that the '526 patent thus fails to teach or suggest selecting one of a broadcast network or a broadband network for transmission of video programming content. The Appellant further submits that the '526 patent fails to teach or suggest that such a selection is based at least in part on an option of delivering the video programming content either at a time that the request is received or at a future time. The Appellant further submits that the '790 publication fails to provide the missing teachings.

The '790 publication, for example, fails to teach or suggest selecting one of a broadcast network or a broadband network for transmission wherein the selection is based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time. In support of the rejection, the Final Office Action states that the system of the '790 publication:

"selects one of the broadcast network or a broadband network" [32] for "transmission of the video programming content to the viewer location ... based upon characteristics

of the transmission request comprising a future time at which the video programming content is requested to be viewed ... [and] at least in part on an option of delivering the video programming content either at a time that the request is received" (ex. start/view now) or "at the future time" (Page 23, Line 17 – Page 24, Line 10).

Final Office Action, page 3. As actually discussed in the '790 publication:

Once the viewer has requested a video-on-demand program, one or more configuration and control screens may appear which require viewer input to complete the order. ... Such data fields may include ... a program start-time field 86 and a start program now field 88.

The '790 publication, page 23, lines 3-12. Moreover:

If a selected video-on-demand program is not to start immediately, it may be fully or partially downloaded into local memory (e.g., in home storage device 35) to lessen the bandwidth required to transmit the program and/or may be transmitted during a non-peak time. A price discount may be offered for such "advance ordering" of a program.... (Underline added.)

The '790 publication, page 24.

The '790 publication thus discusses the use of a "program start-time" for timing of transmission, for provision of a discount, and/or for full/partial download into local memory. The '790 publication, however, fails to teach or suggest using a program start-time as a basis for selection of one of multiple networks for transmission of a selected video-on-demand program. The Advisory Action further states that:

the argument that the combination does not select one of the multiple networks based on option of delivery time is not persuasive. If the system, as aforementioned, distributes the video program to the user at a particular time based upon a request, a selection or choice between one of the aforementioned broadcast or broadband networks must be made in order to deliver the program to the subscriber. This selection is based upon when the video is determined to be delivered in accordance with the subscribers delivery criteria. For example, one of the networks is selected to send the data off-peak if the program is not requested immediately. If the system were not to select one of the networks (ex. subscriber has overdue bills), then the requested program would not be delivered in accordance with the user designated delivery option. (Underline added.)

Advisory Action, page 3. The Appellant respectfully disagrees with the Examiner's conclusion that a selection between broadcast or broadband networks must be made and that this selection is based upon when the video is determined to be delivered.

As set forth in the Manual Of Patent Examining Procedure (MPEP), three basic criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *See*, MPEP Sec. 2143.

The Appellant respectfully submits that even if the '526 patent and the '790 publication are combined, the combination of these references fails to teach or suggest all of the claim limitations as required by MPEP Sec. 2143. In particular, the '526 patent fails to teach or suggest ordering of video programming to be subsequently delivered as conceded by the Final Office Action, much less, selecting a network based on an option of delivering content at a time of request or at a future time. As set forth above, the '790 publication discusses the use of a program start-time for timing of transmission, for provision of a discount, and/or for full/partial download into local memory, but not for selection of a network. Accordingly, even if combined, the cited references when combined fail to teach or suggest all of the claim limitations as required by MPEP Sec. 2143.

The Appellant further submits that there is no motivation in the cited art to modify the reference teachings as set forth in the Office Action. In particular, the only use of program start time in the cited art is for timing of transmission, for discounting, and/or for full/partial download. The Examiner's conclusion that a selection between networks must be made in order to deliver the program to the subscriber and that this selection is based upon when the video is determined to be delivered relies on impermissible hindsight based on the Applicants' disclosure as opposed to the prior art. For example, the Appellant submits that in a conventional system(s), a single user may separately subscribe to services provided by satellite, cable, and broadcast providers, with orders to the satellite provider being serviced over the satellite network, with orders to the cable provider being serviced over the cable network, and with orders to the broadcast provider being serviced over the broadcast network. In such a system, network "selection" may be based on the provider to which the order is placed as opposed to a delivery time.

For at least the reasons discussed above, the Appellant respectfully submits that Claim 1 is patentable over the combination of the '526 patent and the '790 publication. The Appellant further submits that independent Claims 16 and 19 are patentable for reasons similar to those discussed above with regard to Claim 1. In addition, dependent Claims 2-15,

17-18, and 20-30 are patentable at least as per the patentability of Claims 1, 16, and 19 from which they depend.

**B. Dependent Claims 25, 27, And 29 Are Patentable Over The Cited Art**

Dependent Claims 25, 27, and 29 stand rejected under 35 U.S.C. Sec. 103(a) as being unpatentable over the '526 patent in view of the '790 publication, and further in view of U.S. Patent No. 6,438,110 to Rai et al. (hereinafter "Rai"). The Appellant respectfully submits, however, that dependent Claims 25, 27, and 29 are patentable for the reasons discussed above with respect to independent Claims 1, 16, and 19 from which they depend. The Appellant further submits that dependent Claims 25, 27, and 29 are separately patentable for at least the additional reasons discussed below.

Claim 25, for example, depends from Claim 1, and thus includes all recitations of Claim 1 as discussed above. In addition, Claim 25 recites that the video programming content comprises first video programming content, that the transmission request comprises a first transmission request, and that selecting one of the broadcast network or the broadband network comprises selecting the broadcast network. Claim 25 also includes:

- identifying second video programming content to be transmitted based on a second transmission request wherein the first and second transmission requests are different;

- selecting the broadband network for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed, the selection of the broadband network being based at least in part on an option of delivering the second video programming content either at a time that the second request is received or at the future time; and

- transmitting the second video programming content on the broadband network.

Moreover, Claim 1 (from which Claim 25 depends) states that "the broadcast network and the broadband network are different." In support of the rejection of Claim 25, the Final Office Action states that:

The combined Ellis references provide heterogeneous distribution comprising both a "broadcast" and a "broadband network". The Rai et al. reference discloses that the particular selection of a particular network including both "broadcast" and a "broadband networks" wherein the particular selection between networks depends on the scheduled time of the request. Taken in combination, the Rai et al. reference teaches that the particular of scheduling of video programming occurs using either of the "broadband" or "broadcast networks" of the combined Ellis references in order to optimally deliver resources using the available networks.

Final Office Action, page 6. The Advisory Action further states that:

The Ellis ('526) reference contemplates the particular usage of a wide variety of links as well (including some of the same physical types mentioned by Rai et al.) and is analogous to applicant's invention in that it also provides a system and method for content transmission. Rai teaches when dealing with multiple link/network systems that it is desirable to provide a method to schedule services across networks in order to schedule high-quality delivery of services (Col 1, Lines 34 - Col 2, Line 6) which would appear applicable/relevant to the available multiple distribution paths of the combined Ellis references.

Advisory Action, page 4.

Accepting for the sake of argument that the combined Ellis references provide heterogeneous distribution comprising both broadcast and broadband networks which are different, it would not be obvious combine Rai with the Ellis references as suggested by the Examiner. In particular, the Ellis '526 patent discusses television systems (the '529 patent, col. 3, line 11, and col. 10, line 13) with communications paths such as satellite links, telephone network links, cable or fiber optic links, microwave links, Internet links, or combinations of such paths (the '529 patent, col. 3, lines 23-28), and the Ellis '790 publication discusses a television program guide system. In contrast, Rai states that:

The communications network 11 may comprise a computer network, for example a plurality of personal computers, workstations or the like at the node elements 12 connected by a local area network, comprising a link element. The link elements may comprise a wide area network, broadband network, e.g. ATM or SDH or the like. ...

Rai, col. 5, lines 44-49. The Appellant respectfully submits that it would not be obvious to somehow selectively combine aspects of the computer network of Rai with the television systems of the Ellis references to somehow teach or suggest the method of Claim 25.

For at least the reasons discussed above, the Appellant respectfully submits that Claim 25 is separately patentable over the combination of the '526 patent, the '790 publication, and Rai. The Appellant further submits that dependent Claims 27 and 29 are separately patentable for reasons similar to those discussed above with regard to Claim 25. In addition, dependent Claims 26, 28, and 30 are patentable at least as per the patentability of Claims 25, 27, and 29 from which they depend.

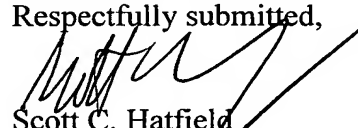
### **III. Conclusion**

In summary, the Appellant respectfully submits that the cited art fails to teach or suggest all recitations of independent Claims 1, 16, and 19 and dependent Claims 25, 27, and

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29 for at least the reasons discussed above. The remaining dependent claims are patentable at least as depending from patentable independent Claims 1, 16, and 19. Accordingly, the Appellant respectfully requests reversal of the rejections of the subject matter of Claims 1-30.

Respectfully submitted,

  
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\_\_\_\_\_  
Joyce Paoli

### **Appendix A: Claims**

1. (rejected) A method for content transmission network selection in a system coupled in parallel through both of a broadcast network and a broadband network to a viewer location wherein the broadcast network and the broadband network are different, the method comprising the steps of:

identifying video programming content to be transmitted to the viewer location based on a transmission request;

selecting one of the broadcast network or the broadband network for transmission of the video programming content to the viewer location based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed, the selection based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time; and

transmitting the video programming content on the selected one of the broadcast network or the broadband network to the viewer location coupled to both of the broadcast and broadband networks.

2. (rejected) A method as in claim 1, wherein the step of identifying content to be transmitted based on a transmission request comprises the steps of:

transmitting a list of available content items over the broadband network; and  
receiving from the broadband network requests for content items.

3. (rejected) A method as in claim 22, wherein said step of selecting one of the broadcast network or the broadband network comprises the steps of:

determining whether there is sufficient available bandwidth in the broadcast network to transmit the content;

if there is not sufficient available bandwidth in the broadcast network, then  
determining to transmit the content over the broadband network;

if there is a sufficient available bandwidth in the broadcast network, then determining whether the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network;

if the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network, then determining to transmit the content over the broadband network; and

if the cost of transmitting the content over the broadcast network does not exceed the cost of transmitting the content over the broadband network, then determining to transmit the content over a broadcast network.

4. (rejected) A method as in claim 3, wherein said step of determining whether there is sufficient available bandwidth in the broadcast network to transmit the content comprises the steps of:

determining the available bandwidth in the broadcast network;

determining the minimum transfer rate for the content;

determining whether the minimum transfer rate for the content exceeds the available bandwidth in the broadcast network;

if the minimum transfer rate for the content exceeds the available bandwidth in the broadcast network, then determining that there is not sufficient available bandwidth in the broadcast network to transmit the content; and

if the minimum transfer rate for the content does not exceed the available bandwidth in the broadcast network, then determining that there is sufficient available bandwidth in the broadcast network to transmit the content.

5. (rejected) A method as in claim 3, wherein said step of determining whether the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network comprises the steps of:

determining a cost of transmission per unit of data over the broadband and broadcast networks;

determining the total number of units of data in the content; and

determining if the product of the total number of units of data in the content and cost of transmission per unit of unit of data over the broadcast network exceeds the product of the total number of units of data in the content and cost of transmission per unit of data over the broadband network.



6. (rejected) A method as in claim 1, wherein said broadcast network comprises one of a direct to home satellite network, a terrestrial wireless network, and a cable network.

7. (rejected) A method as in claim 1, wherein said broadband network comprises one of a digital subscriber line network and a cable network.

8. (previously presented) A method as in claim 1, wherein said characteristics of the transmission request further comprise at least one of the geographic location to which the content is to be transmitted and a dollar amount the viewer is willing to pay for the content.

9. (previously presented) A method as in claim 22, wherein said characteristics of the content to be transmitted comprise at least one of the following: size of the content, duration of the content, the total number of requests for the content, and the minimum transmission rate on a given network for the content.

10. (previously presented) A method as in claim 22, wherein said characteristics of the broadcast network comprise at least one of the available bandwidth on the network, the geographic boundaries of the network, and the cost of transmission at a given time of day on the network.

11. (previously presented) A method as in claim 22, wherein said characteristics of the broadband network comprises of at least one of the following: available bandwidth on the network, geographic boundaries of the network; and cost of transmission at a given time of day on the network.

12. (rejected) A method as in claim 1, further comprising the step of transmitting over a broadcast network a notification of the transmission characteristics.

13. (rejected) A method as in claim 12, wherein said transmission characteristics comprise an identification of a transmission network.

14. (rejected) A method as in claim 1, wherein said step of transmitting the content on one of the broadcast network or the broadband network comprises transmitting the content

on one of the broadcast network or the broadband network at a time prior to the future time at which the content is requested to be viewed.

15. (rejected) A method as in claim 1, wherein said step of transmitting the content on one of the broadcast network or the broadband network comprises transmitting the content on one of the broadcast network or the broadband network at the future time at which the content is requested to be viewed.

16. (rejected) A computer readable medium for a transmission network selector coupled in parallel through both of a broadcast network and a broadband network to a viewer location wherein the broadcast network and the broadband network are different, the computer readable medium having stored thereon computer readable instructions for performing the following steps:

identifying video programming content to be transmitted to the viewer location based on a transmission request;

selecting one of the broadcast network or the broadband network for transmission of the video programming content to the viewer location based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed, the selection based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time; and

transmitting the video programming content on the selected one of the broadcast network or the broadband network to the viewer location.

17. (rejected) The computer readable medium of claim 23, wherein said instructions for performing the step of selecting one of the broadcast network or the broadband network comprise instructions for performing the following steps:

determining whether there is sufficient available bandwidth in the broadcast network to transmit the content;

if there is not sufficient available bandwidth in the broadcast network, then determining to transmit the content over a broadband network;

if there is a sufficient available bandwidth in the broadcast network, then determining whether the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network;

if the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network, then determining to transmit the content over a broadband network; and

if the cost of transmitting the content over the broadcast network does not exceed the cost of transmitting the content over the broadband network, then determining to transmit the content over the broadcast network.

18. (rejected) The computer readable medium of claim 16 having stored thereon computer readable instructions for further performing the step of transmitting over the broadcast network a notification of the transmission characteristics.

19. (rejected) A system for content transmission network selection wherein the system is coupled in parallel through both of a broadcast network and a broadband network to a viewer location wherein the broadcast network and the broadband network are different, the system comprising:

a processor operative to execute computer executable instructions; and

memory having stored therein computer executable instructions for performing the following steps:

identifying video programming content to be transmitted to the viewer location based on a transmission request;

selecting one of the broadcast network or the broadband network for transmission of the video programming content to the viewer location based upon characteristics of the transmission request comprising a future time at which the video programming content is requested to be viewed, the selection based at least in part on an option of delivering the video programming content either at a time that the request is received or at the future time; and

transmitting the video programming content on one the selected of the broadcast network or broadband network to the viewer location.

20. (rejected) The system of claim 24, wherein said computer executable instructions for performing the step of selecting one of the broadcast network or the broadband network comprise computer executable instructions for performing the following steps:

determining whether there is sufficient available bandwidth in the broadcast network to transmit the content;

if there is not sufficient available bandwidth in the broadcast network, then determining to transmit the content over a broadband network;

if there is a sufficient available bandwidth in the broadcast network, then determining whether the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network;

if the cost of transmitting the content over the broadcast network exceeds the cost of transmitting the content over the broadband network, then determining to transmit the content over a broadband network; and

if the cost of transmitting the content over the broadcast network does not exceed the cost of transmitting the content over the broadband network, then determining to transmit the content over a broadcast network.

21. (rejected) The system of claim 19, wherein said memory has stored therein computer executable instructions for further performing the step of transmitting over the broadcast network a notification of the transmission characteristics.

22. (rejected) The method of claim 1, comprising selecting one of the broadcast network or the broadband network based upon the characteristics of the transmission request and at least one of the following: characteristics of the content to be transmitted, characteristics of the broadcast network, and characteristics of the broadband network.

23. (rejected) The computer readable medium of claim 16, comprising computer readable instructions for selecting one of the broadcast network or the broadband network based upon the characteristics of the transmission request and at least one of the following: characteristics of the content to be transmitted, characteristics of the broadcast network, and characteristics of the broadband network.

24. (rejected) The system of claim 19, comprising computer executable instructions for selecting one of the broadcast network or the broadband network based upon the characteristics of the transmission request and at least one of the following: characteristics of the content to be transmitted, characteristics of the broadcast network, and characteristics of the broadband network.

25. (rejected) A method as in Claim 1 wherein the video programming content comprises first video programming content, wherein the transmission request comprises a first transmission request, and wherein selecting one of the broadcast network or the broadband network comprises selecting the broadcast network, the method further comprising:

identifying second video programming content to be transmitted based on a second transmission request wherein the first and second transmission requests are different;

selecting the broadband network for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed, the selection of the broadband network being based at least in part on an option of delivering the second video programming content either at a time that the second request is received or at the future time; and

transmitting the second video programming content on the broadband network.

26. (rejected) A method according to Claim 25 wherein transmitting the first video programming content on the broadcast network comprises transmitting the first video programming content on the broadcast network without using the Internet, and wherein transmitting the second video programming content on the broadband network comprises transmitting the second video programming content on the broadband network including the Internet.

27. (rejected) The computer readable medium of Claim 16 wherein the video programming content comprises first video programming content, wherein the transmission request comprises a first transmission request, and wherein selecting one of the broadcast network or the broadband network comprises selecting the broadcast network, the computer

readable medium further having stored thereon computer readable instructions for performing the following steps:

identifying second video programming content to be transmitted based on a second transmission request wherein the first and second transmission requests are different;

selecting the broadband network for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed, the selection of the broadband network being based at least in part on an option of delivering the second video programming content either at a time that the second request is received or at the future time; and

transmitting the second video programming content on the broadband network.

28. (rejected) The computer readable medium of Claim 27 wherein transmitting the first video programming content on the broadcast network comprises transmitting the first video programming content on the broadcast network without using the Internet, and wherein transmitting the second video programming content on the broadband network comprises transmitting the second video programming content on the broadband network including the Internet.

29. (rejected) The system of Claim 19 wherein the video programming content comprises first video programming content, wherein the transmission request comprises a first transmission request, and wherein selecting one of the broadcast network or the broadband network comprises selecting the broadcast network, the memory further having stored therein computer executable instructions for performing the following steps:

identifying second video programming content to be transmitted based on a second transmission request wherein the first and second transmission requests are different;

selecting the broadband network for transmission of the second video programming content based upon characteristics of the second transmission request comprising a second future time at which the second video programming content is requested to be viewed, the selection of the broadband network being based at least in part on an option of delivering the second video programming content either at a time that the second request is received or at the future time; and

transmitting the second video programming content on the broadband network.

30. (rejected) The system of Claim 29 wherein transmitting the first video programming content on the broadcast network comprises transmitting the first video programming content on the broadcast network without using the Internet, and wherein transmitting the second video programming content on the broadband network comprises transmitting the second video programming content on the broadband network including the Internet.

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#### **Appendix B: Evidence**

No evidence pursuant to 37 CFR Sec. 1.130, Sec. 1.131, or Sec. 1.132 is relied upon by Appellant in the appeal.



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### **Appendix C: Related Proceedings**

There are no related proceedings pursuant to 37 C.F.R. Sec. 41.37.



AP 12157  
JW

Attorney Docket No. 9400-212

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Paul T. Watson, et al.

Application Serial No.: 10/028,153

Group No.: 2157

Filed: December 20, 2001

Examiner: Emmanuel Coffy

For: **SYSTEM AND METHOD FOR CONTENT TRANSMISSION NETWORK  
SELECTION**

Date: June 2, 2006

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL OF APPEAL BRIEF  
(PATENT APPLICATION--37 C.F.R. § 41.37)**

1. Transmitted herewith is the APPEAL BRIEF for the above-identified application, pursuant to the Notice of Appeal filed on April 7, 2006.

2. This application is filed on behalf of  
☐ a small entity.


3. Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is authorized to be charged to our Deposit Account 50-0220.

<input type="checkbox"/>	small entity	\$250.00
<input checked="" type="checkbox"/>	other than small entity	\$500.00

Appeal Brief fee due \$500.00

☒ Any additional fee or refund may be charged to Deposit Account 50-0220.

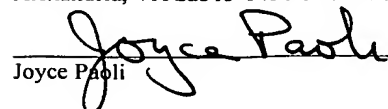
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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 2, 2006.

  
Joyce Paoli